

**REMARKS**

**I. Status Of The Claims**

Claims 1-32 are pending in this application. Claim 31 has been amended. No claims have been added. No claims have been canceled. The Examiner has withdrawn claims 3-13, thus, claims 1-7 and 14-32 have been examined.

**II. Rejections Under 35 USC § 102**

A. Arraudeau et al.

Claims 1, 4-7, 15-18, 20, 23, 24 and 26-32 stand rejected under 35 USC § 102(b) as being anticipated by Arraudeau et al., U.S. Patent No. 4,659,562. Applicant continues to respectfully traverse this rejection for the reasons of record and those that follow:

Independent claims 1, 29 and 30 each recite "wherein said fibers are compatibilized with a fatty phase by at least one polyol." In the previous Amendment filed May 22, 2001, the Applicant directed the Examiner's attention to the definition of "compatibilized" provided in the specification at page 8, lines 5-7.

In the Final Office Action, the Examiner states that claims "are permitted to be given their broadest reasonable interpretation," and thus it is "the position of the Examiner that 'compatibilized' is to establish a stable formulation without reacting chemically or interfering with others." According to the Examiner, if a composition "provides a very satisfactory cosmetic composition," the fiber is compatibilized with the fatty phase.

Although an examiner must interpret a claim as broadly as its terms reasonably allow, words of the claim must be given their plain meaning "unless applicant has provided a clear definition in the specification" (MPEP § 2111.01).

It is also well settled patent law that an applicant may be his own lexicographer as long as the meaning given to a term is not repugnant to the term's well-known usage (MPEP § 2111.02). "Any special meaning assigned to a term 'must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention'" (MPEP § 2111.01).

As Applicant pointed out previously, Applicant has provided a clear meaning of "compatibilized" in the specification. This meaning is not repugnant to any common usage understood by those of ordinary skill in the art. Thus, Applicant respectfully requests that the

Examiner properly interpret the claims in light of the present specification, and particularly in light of the clear meaning of "compatibilized" provided in the specification.

Accordingly, Applicant maintains that Arraudeau et al. fails to disclose an anhydrous care or make-up composition comprising fibers wherein the fibers are compatibilized with a fatty phase by at least one polyol (claim 1), or a lipstick or a lip gloss etc., comprising fibers wherein the fibers are compatibilized with a fatty phase by at least one polyol (claim 29) or a cosmetic care or treatment process for human keratin substances comprising fibers wherein the fibers are compatibilized with a fatty phase by at least one polyol (claim 30).

Likewise, Arraudeau fails to disclose a method for improving the staying power over time and/or a method for improving the gloss of an anhydrous care or make-up composition comprising compatibilizing fibers in the anhydrous care or make-up composition, as recited in claim 31, as amended.

For at least these independent reasons, Applicant submits that none of the pending claims are anticipated by Arraudeau et al. Accordingly, Applicant respectfully requests withdrawal of this rejection.

B. Franzke et al.

Claims 1, 4-7, 14-18, 20, 23, 24 and 26-28 stand rejected under 35 USC § 102(e) as being anticipated by Franzke et al., U.S. Patent No. 5,965,146. Applicant continues to respectfully traverse this rejection for the reasons of record and those that follow.

As stated in the previous Amendment filed May 22, 2001, the recitation of "anhydrous composition" in independent claim 1 has a clear meaning provided by the specification at page 5, lines 6-10, *i.e.*, "a composition comprising a homogenous continuous fatty phase in which may be dispersed ingredients that are insoluble in the fatty phase... such as dyestuffs and cosmetic or dermatological active agents, including water."

The Examiner notes that Franzke discloses that water can be present in the composition in an amount from 0.1 to 30% by weight, "which clearly falls in the water content defined in the Applicant's specification" (Office Action at page 4).

Applicant submits that Franzke fails to disclose a composition comprising a homogeneous continuous fatty phase. Those of ordinary skill in the art would readily recognize

that water content alone does not determine whether a composition comprises a homogeneous continuous fatty phase, as has been alleged by the Examiner.

It appears that the Examiner is relying on Franzke via a theory of inherency, as Franzke provides no disclosure of a homogeneous continuous fatty phase. According to the Examiner, if Franzke discloses a water content that falls within the scope of claim 1, Franzke then inherently discloses a homogenous fatty phase. Applicant respectfully disagrees.

It is well settled patent law that the “fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic” (MPEP § 2112). “To establish inherency, the intrinsic evidence must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient” (MPEP § 2112) (emphasis added).

Thus, by pointing to the water content in Franzke and no other specific teaching in Franzke that would lead those of ordinary skill in the art to conclude that Franzke inherently discloses a homogeneous continuous fatty phase, the Examiner is relying only on the possibility that the composition of Franzke may provide an anhydrous composition comprising a homogeneous fatty phase. The Examiner states that Franzke discloses “glycols, silicone oil and polymers.” This general disclosure also is only relied on for the possibility that Franzke may disclose a homogeneous fatty phase. Such a general disclosure, however, is not sufficient under a theory of inherency.

Applicant furthermore submits that, “the identical invention must be shown in as complete detail as is contained in the . . . claims . . . the elements must be arranged as required by the claim” (MPEP § 2131).

Those of ordinary skill in the art would readily recognize that Franzke fails to disclose sufficient detail to provide a homogenous continuous fatty phase. The vast number of ingredients and ranges disclosed in Franzke provides an almost infinite number of possibilities. Such near infinite number of possibilities provides insufficient detail to show those of ordinary skill in the art that Franzke discloses the identical invention, as recited in Applicant’s claims.

Applicant previously noted that Franzke’s examples disclose aqueous or ethanol-based compositions, but not a homogenous continuous fatty phase. In response, the Examiner stated

“Franzke can not be limited to his best mode as described in the examples.” Applicant’s statement, however, is not limited to Franzke’s alleged best mode. Indeed, the first sentence of the abstract of Franzke describes the mention of Franzke as an “aqueous or aqueous/alcoholic cosmetic composition.” The numerous examples (25 in all) each exemplify a composition based on aqueous phases, aqueous/alcoholic phases, or other non-fatty phases. Applicant’s arguments are hardly limiting Franzke to a best mode, but rather to the invention disclosed therein.

Moreover, all of the examples in Franzke provide aqueous or aqueous/alcoholic cosmetic compositions having a water content of 6.5-96 %, placing all of Franzke’s exemplary compositions outside the scope of applicant’s anhydrous compositions. Thus, Franzke’s aqueous and aqueous/alcoholic compositions teach the skilled artisan away from the preparation of an anhydrous composition. The Examiner has failed to point to any contradictory teachings in Franzke.

Thus, Franzke fails to disclose a composition comprising an anhydrous composition comprising a homogeneous fatty phase, as recited in Applicant’s claims 1-28.

For at least this reason, none of the rejected claims are anticipated by Franzke. Accordingly, Applicant respectfully requests withdrawal of this rejection.

### **III. Rejection under 35 USC § 103**

Claims 2, 3, 14-22 and 25-32 stand rejected under 35 USC § 103(a) as being unpatentable over Arraudeau et al., in view of Bara et al. (U.S. Patent No. 6,177,091) and Arnaud (FR. 278393 A1, Abstract). Applicant continues to respectfully traverse this rejection.

The Abstract of Arnaud was published on June 2, 2000, which does not antedate either the French priority document of the present application (filed May 20, 1999) or the U.S. filing date of the present application (May 22, 2000). As Arnaud fails to meet any of the requirements of a proper reference based on 35 U.S.C. § 102, Arnaud is not applicable as a reference under 35 U.S.C. § 103 and should be disqualified from this rejection.

As stated previously in section II.A. of this Amendment, independent claim 1 is directed to a composition comprising fibers, wherein the fibers are compatibilized with a fatty phase by at least one polyol. This relevant limitation is also recited in independent claims 29 and 30, as well as claim 31, as amended.

As demonstrated above, Arraudeau et al. fails to teach, suggest or provide a motivation for preparing a composition comprising fibers wherein the fibers are compatibilized with a fatty phase by at least one polyol. Bara et al. is directed to compositions comprising an organopolysiloxane and a fatty phase. Bara et al. fails to teach, suggest or provide a motivation for the use of fibers in its composition.

Applicant submits that those of ordinary skill in the art having knowledge of Arraudeau et al.'s composition comprising fibers would not find it obvious to substitute Arraudeau's composition base with the base of the composition of Bara et al. and to compatibilize Arraudeau's fibers in the Bara base, due to a lack of clear teaching or suggestion in the references. Therefore, the Examiner has not established a *prima facie* case of obviousness.

The facts of this case similar to those of *In re Dembiczak*. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). In *Dembiczak*, claims directed to a plastic trash bag featuring a pumpkin face were held obvious by the Board in view of references teaching pumpkin faces on crepe paper and a "paper bag pumpkin" stuffed with newspapers. The Board found it obvious to place facial indicia elements outside plastic trash bags because the references taught painting jack-o-lantern faces on paper bags.

The Federal Circuit held that the Board failed to note any specific teaching of the combination of facial indicia on plastic trash bags. According to the Federal Circuit, the Board merely detailed the similarities between the references and the claims. *In re Dembiczak*, 175 F.3d at 1000. "[T]his reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest a combination with a conventional trash or lawn bags to yield the claimed invention." *Id.*

Similarly, there is no specific teaching to combine the fibers of Arraudeau with the cosmetic base of Bara. Neither reference, taken alone or in combination, appears to recognize the benefits of the presence of stabilizing fibers in a homogenous continuous fatty phase. It appears that the only basis for this rejection is combining elements from individual references, similar to the "reference-by-reference, limitation-by-limitation analysis" carried out by the Board in *Dembiczak*, which is improper.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

#### IV. Conclusion

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In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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APPENDIX A: AMENDED CLAIM 31

31. (Amended) A method of improving the staying power over time and/or gloss of an anhydrous care or make-up composition containing a fatty phase and at least one polyol that is liquid at room temperature comprising [including] compatibilizing fibers in said anhydrous care or make-up composition.

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